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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANTS : NICKEL, Oliver  
SERIAL NO. : 09/431,849  
FILED : 2 November 1999  
FOR : MASKING STRIP AND USE THEREOF  
ART UNIT : 1774  
EXAMINER : Lawrence D. Ferguson

4 August 2003

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22312-1450

APPELLANTS' REPLY BRIEF ON APPEAL  
PURSUANT TO 37 CFR § 1.193(b)(1)

SIR:

Certain arguments present by the Examiner in the Examiner's Answer merit a brief reply.

First, while the appellants acknowledge that the rejection is based on a combination of references, the appellants do not agree with the examiner's assertion that the references are being attacked individually. The appellants are merely pointing out that reliance on a combination of references does not absolve the Examiner of consideration of the *Graham v. John Deere Co.* factors or "applying...", the following the tenets of patent law which must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and they must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard by which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143, n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)." - see also MPEP 2141. It is believed that the Examiner has not provided the requisite motivation for combining the references in the manner described nor has he been able to make the combination without resorting to impermissible hindsight reconstruction.

Second, if the Examiner's reliance on the *In re Keller* and *In re Merck & Co.* decisions are meant to somehow establish a lesser standard necessary for establishing a *prima facie* case of obviousness when combining multiple references, the appellants vehemently disagree with such an interpretation and even if such an interpretation was permissible, it is presented that MPEP 2144 states that "If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court."

The facts in both the *Keller* and the *Merck* decisions were based on situations which are far removed from what is present in this application. In the *Keller* decision, the claims were virtually identical to the primary reference except for the fact that the primary reference taught analog time base generators rather than the digital time base generators. In the *Merck* decision, the antidepressive properties of a known compound, amitriptyline, were stated to be obvious over prior art which described a structurally similar compound, imipramine, which possessed the same properties and prior art which established that it was known in the art that similar structure would be expected to have similar properties. Such degree of similarity is not present in this application and as such, the burden for combining the references to establish a *prima facie* case of obviousness would appear to be increased not decreased when viewed in light of *Keller* and *Merck*.

For the foregoing reasons and for the reasons advanced in Appellants' principal brief, Appellants respectfully request that the Honorable Board reverse the final rejection.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By: Howard C. Lee

Howard C. Lee  
Reg. No. 48,104

220 E. 42<sup>nd</sup> Street  
30<sup>th</sup> Floor  
New York, NY 10017  
(212) 808-0700

NOTE: A request for oral hearing is being filed concurrently with this reply brief. In the event that these papers become lost, it is requested that the appellants' representative be contacted so that a duplicate copy may be faxed/mailed to the Board.

<b>CONDITIONAL PETITION FOR EXTENSION OF TIME</b>
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If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

<b>ADDITIONAL FEE</b>
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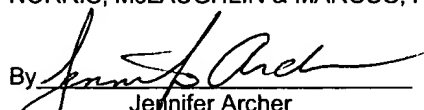
Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Services as Express Mail Label No. EV208799499US in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313 on the date indicated below.

NORRIS, McLAUGHLIN & MARCUS, P.A.

By

  
Jennifer Archer

Date: 4 August 2003